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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,138	02/13/2002	Darrell R. Anderson	P 0280705 1995-30-0233CP1	7969

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Pillsbury Winthrop LLP
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EXAMINER	
GAMBEL, PHILLIP	

ART UNIT	PAPER NUMBER
1644	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,138	ANDERSON ET AL.	
	Examiner	Art Unit	
	Phillip Gambel	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This application appears to be in compliance with the Sequence Rules.

2. Prior to setting forth the restriction requirement, it is pointed out that the claims are drawn to patentably distinct products and methods, which rely upon differ ingredients, process steps and endpoints, which, in turn, require non-coextensive searches to such an extent that they are considered separately patentable. Both the claimed products and methods rely upon antibodies that bind B7-1 or B7-2. B7-1 and B7-2 differ in structure, expression and modes of action to such an extent and require non-coextensive searches to such an extent that they are considered separately patentable. Therefore, the restriction will be set forth for each of the various Groups, irrespective of the format of the claims.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-3, 6, 7, 9-14 and 26, drawn to anti-B7-1 antibodies and compositions thereof, classified in Class 424, subclass 153.1 and Class 530, subclass 387.1.

II. Claims 1, 4-6, 8-13, 15 and 26, drawn to anti-B7-2 antibodies and compositions thereof, classified in Class 424, subclass 141.1 and Class 530, subclass 388.1.

III. Claims 16, 18, 20, 22, 24 and, 27, drawn to a method of treating a disease with anti-B7-1 antibodies, classified in Class 424, subclass 130.1.

IV. Claims 17, 19, 21, 23, 25 and 28, drawn to a method of treating a disease with anti-B7-2 antibodies, classified in Class 424, subclass 173.1.

4. (Inventions I and III) and (Inventions II and IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the products as claimed can be used in a materially different process such as affinity purification or detection assays .

5. Inventions I and II are different methods, which require different ingredients, process steps and endpoints. In particular, Both the claimed methods rely upon antibodies that bind B7-1 or B7-2. B7-1 and B7-2 differ in structure, expression and modes of action to such an extent and require non-coextensive searches to such an extent that they are patentably distinct.

6. Inventions I and II are different products. The inventions encompass antibodies that bind B7-1 and B7-2. B7-1 and B7-2 differ in structure, expression and modes of action to such an extent and require non-coextensive searches to such an extent that they are patentably distinct.

7. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-IV is not required for any other group from Groups I-IV and Groups I-IV have acquired a separate status in the art because the searches are not co-extensive and encompass divergent subject matter, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed Invention III and IV: wherein the disease is:

A) an autoimmune disorder,
B) transplant rejection,
C) GVHD,
D) B cell lymphoma,
E) infectious diseases, or
F) inflammatory diseases.

These species are distinct because the pathological conditions differ in etiologies and therapeutic endpoints.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16 and 17 are generic for example.

In addition to electing Invention III or IV and a disease selected from (A) – (F), applicant is required to elect a specific species as it reads on (A) – (F) as disclosed on page 37, paragraph 1 of the instant specification.

9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (571) 272-0844. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PHILLIP GAMBEL

Phillip Gambel, PhD.
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September 30, 2004